

REMARKS

Claims 1-47 are currently pending in this application. Claims 42-47 are new and incorporate limitations of claims 1 and 36. Claims 1, 8, 19, 21, 22, 35, 36, 40 and 41 have been amended while the remaining claims are unchanged. No new subject matter is believed to have been added by this amendment.

On page 2 of the Office Action, the Examiner rejects various claims based upon informalities as spelled out on this page. As a result, claims 1, 22, and 41 have been amended to address these informalities.

On pages 3-6 of the Office Action, the Examiner rejects claims 1, 7, 8, 9, 12, 13, 14, 15, 21, 25, 26, 27, and 28 under 35 U.S.C. §103(a) as being obvious from the teaching of United States Patent No. 5,832,457 to O'Brien et al. (the O'Brien patent) in view of the teaching of the article "IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?" by Galler (the Galler article). The O'Brien patent is directed to a method and apparatus for selective distribution of discount coupons based on prior customer behavior. Such discount coupons are provided immediately after checkout and require the customer to be present in the establishment. The establishment knows the customer is present in their store only at or after checkout. The prior customer behavior referenced in the O'Brien patent is that behavior associated with a single establishment or franchise. As an example, a supermarket may track the purchases of a particular customer during a visit and, in subsequent visits by that customer, provide coupons directed to the particular needs or interests of that customer based on the prior customer behavior at that supermarket. Furthermore, as described in the Abstract, the O'Brien patent is directed to a system for automatically distributing discount coupons or certificates in a retail store conditioned on a pre-selected combination of present and past shopping behavior of a customer whose order is being processed at a check-out stand. The customer has already shopped in the store and is essentially being rewarded to purchase more or to return to the store based upon data generated while the customer was present and shopping in the store. No customer data is collected absent such a store visit. Essentially, the O'Brien patent is directed to a post-sale marketing method where the sale occurs at the store.

Claim 1, as amended, on the other hand, is directed to a method of creating direct marketing opportunities for individuals known in advance to be visiting a specified retail outlet for pick up or return of a product shipped from a seller unrelated by ownership to

that specific retail outlet and providing information for target marketing before, during or after visiting the retail outlet. Therefore, the retail outlet has an opportunity to direct market to an individual that normally would not visit their store or to a regular customer they would not otherwise know in advance was intending to visit the store. In accordance with claim 1, the seller is not related to the retail outlet by ownership and furthermore, at least a portion of the information on the individual is provided by the individual at the time the order is placed for the product to be shipped to, or from, the store. Therefore, the compilation of information on an individual begins before the individual visits a retail outlet and even before the individual identifies a retail outlet to visit.

These features are neither taught nor suggested by the O'Brien patent.

The Examiner indicates on page 3 of the Office Action, that the Abstract of the O'Brien patent teaches compiling information from the existence of a database with such information. However, a further reading of the Abstract in O'Brien makes clear that customer-supplied data is obtained from a customer identification data base, past shopping activity, data gather during previous customer visits to the store, and present shopping activity, as evidenced by items identified in the current customer order. Furthermore, in column 6, lines 17-52, past customer behavior data can either be derived from existing databases or gathered by the apparatus of the invention in the O'Brien patent. As explained, existing databases are those databases created by the store with customer identification cards previously provided to the customers. Therefore all of the customer supplied data disclosed in the O'Brien patent is data supplied directly to the retail outlet by the customer and is provided as a result of direct communication with that outlet. In the O'Brien scenario, the retail outlet is the only seller and all information about the individual is solicited by and compiled by the retail outlet/seller. Claim 1 states the seller is unrelated to the retail outlet.

The Galler article describes the activities of PackageNet and in particular suggests the pick up or return of a pre-ordered product, which is not discussed in the O'Brien patent. However, the PackageNet system as described in the Galler article merely permits a purchaser to pick up or return a product from any one of a number of different locations. There is neither a teaching nor a suggestion of collecting marketing information, of providing this information to outlets, or of using such information to directly market to the individual associated with the product, as found in claim 1.

For these reasons, the Applicants do not believe that claim 1, as amended, is obvious in view of these cited references and, therefore, is believed to be patently distinct over the cited references and the other art of record. Additionally, claims 7, 8, 9, 12, 13, 14, 15, 21, 25, 26, 27, and 28, based upon their dependence upon what is believed to be patentably distinct independent claim 1, are themselves believed to be patentably distinct. Furthermore, in rejecting claim 27, the Examiner indicates that the O'Brien patent is directed to target marketing. As previously mentioned, the O'Brien patent neither teaches nor suggests using information gathered before the individual visited the store to target market nor does it teach or suggest any marketing in advance of a known store visit. Each of these features is found in claim 27.

On pages 6-7 of the Office Action, the Examiner rejects claim 2 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 2 is itself believed to be patentably distinct.

On page 7 of the Office Action, the Examiner rejects claim 3 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 3 is itself believed to be patentably distinct.

On page 8 of the Office Action, the Examiner rejects claim 4 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 4 is itself believed to be patentably distinct.

On pages 8-9 of the Office Action, the Examiner rejects claim 5 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 5 is itself believed to be patentably distinct.

On page 9 of the Office Action, the Examiner rejects claim 6 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of

the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 6 is itself believed to be patentably distinct.

On pages 9-10 of the Office Action, the Examiner rejects claims 10 and 11 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claim 10 and 11 are themselves believed to be patentably distinct.

On page 10 of the Office Action, the Examiner rejects claim 16 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 16 is itself believed to be patentably distinct.

On page 11 of the Office Action, the Examiner rejects claims 17 and 18 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claims 17 and 18 are themselves believed to be patentably distinct.

On page 11 of the Office Action, the Examiner rejects claims 19 and 20 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claims 19 and 20 are themselves believed to be patentably distinct.

On pages 12-13 of the Office Action, the Examiner rejects claim 22, 23, and 24 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claims 22, 23, and 24 are themselves believed to be patentably distinct.

On pages 13-14 of the Office Action, the Examiner rejects claim 29, 30, and 33 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of official notice. While the O'Brien patent has already been discussed, the Galler article reveals that the PackageNet system was

based upon the customer paying \$3 for the privilege of picking up a package shipped to a store. The subject application, on the other hand, is based upon the opposite premise of providing benefits to a customer to pick up a package shipped to a store and thereafter to accept marketing. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claims 29, 30, and 32 are themselves believed to be patentably distinct.

On pages 14-15 of the Office Action, the Examiner rejects claims 34 and 35 under 35 U.S.C. §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and of official notice and furthermore in view of the articles of the PackageNet web site. Claim 34 and 35 depend from what is believed to be patentably distinct independent claim 1 and therefore, are themselves believed to be patentably distinct.

On pages 15-17 of the Office Action, the Examiner rejects claims 36, 37, and 40 under 35 U.S.C. §103(a) as being obvious from the teaching of the anonymous article titled "Babbage's Expands Online" (hereinafter the Babbage article), in view of official notice. The Babbage article is directed to an e-commerce operation wherein a potential customer alerts a particular retailer that he/she is interested in a certain product, such as a video game. When the product is in stock, the potential customer is contacted by e-mail or telephone so that he/she may purchase and pickup the product. First of all, these potential customers are just that. They have not purchased a product but merely indicated an interest in purchasing such a product. Therefore, they are not known to be visiting a specific retail outlet within a future time period and such marketing may be ineffective if the potential customer does not visit the store and purchase the product. Second of all, the product is not shipped from a seller unrelated by ownership to that particular retail outlet. There is no teaching or suggestion of either of these features in the Babbage article or in view of official notice. Furthermore, the Babbage article does not teach or suggest at all the creation of marketing opportunities or the sending of marketing messages relating to a visit to pick up a pre-ordered product. The potential customer initiates contact with the retail outlet and essentially asks for notice when a particular product is available. This is not target marketing, which as defined on page 7 of the Specification, requires an advertising message. For these reasons, claim 36 is believed to be patentably distinct over the teaching of the Babbage article and of official notice and therefore is believe to be patentably distinct over the prior art of record. By way of their dependence upon what is believed to be patentably

distinct independent claim 36, dependent claims 37 and 40 are themselves believed to be patentably distinct over the prior art of record.

On pages 17-18 of the Office Action, the Examiner rejects claims 38 and 39 under 35 U.S.C. §103(a) as being obvious from the teaching of the Babbage article in view of official notice and further in view of the article titled "Till Death Do You Part..." by Edelstein (hereinafter the Edlestein article). The Babbage article has already been discussed. The Edlestein article teaches a method of encouraging customers to return to a catalog seller for additional shopping by informing them, through a telephone call or a post card, that a new product has arrived. This technique appears to be applied to existing customers only, for whom the store owner has already collected data. Furthermore, even with a telephone call or post card announcing a new product, these customers were not certain to visit the store again. Therefore, the combination of the teaching of the Babbage article and the Edlestein article does not make obvious claims 38 and 39 because each of these requires knowledge of the future period in which an individual will be visiting the store, as stated in claim 36. Furthermore, by way of their dependence upon what is believed to be patentably distinct independent claim 36, dependent claims 38 and 39 are themselves believed to be patentably distinct over the prior art of record.

On pages 19-20 of the Office Action, the Examiner has indicated that claims 31 and 32 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §101 and if rewritten in independent form. The Applicants recognize these allowable claims and reserves the right to add these claims at a later time in the prosecution of this application.

Claims 1, 36 and 41 have been further amended to focus upon pick up of a product and marketing to the individual before he/she visits the retail outlet. New claims 42-47 have been added to address the return of a product and marketing to the individual during or after a visit to a retail outlet.

During the telephone interview of May 5, 2005, the Examiner indicated that United States Patent No. 6,754,636 to Walker et al. (the Walker patent) should be considered. The Walker patent is directed to a purchasing system wherein a buyer takes possession at a retail outlet of a product purchased using a communication network. Worded differently, the Walker patent is directed to brokering an existing purchaser of a specified product, rather than marketing to an individual known in advance to be visiting a specific retail outlet and thus to potential customers. In particular, a buyer through the services of a purchasing

system, purchases a product and is issued a voucher which permits that purchaser to pick up the product at any of a number of different retail outlets. As stated in column 6, lines 5-11, the buyer pays the purchasing system in exchange for the right to take possession of the product at the retailer. As further stated in column 8, line 52-column 9, line 3, a single voucher for a VCR might indicate that the buyer could take possession of the VCR at either of three local retailers. The voucher may also include an offer to purchase a pack of 3 VCR tapes for \$1.00 to the buyer if the buyer takes possession of the VCR at a particular retail outlet. However, it is important to note that the purchaser is not committed to visiting one or another retail outlet and that the voucher is good at any of a number of retail outlets upon presentation. There is no advance notice to the retail outlet that the buyer will be redeeming his/her voucher at that outlet.

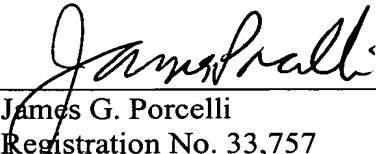
On the other hand, the method of target marketing requires, as clearly stated in independent claim 1, identifying , with the use of a computer, an individual known in advance by an administrator or supplier to be visiting within a future time period a specific retail outlet for pick up or return of a product specifically ordered from a seller by the individual and shipped from the seller to the retail outlet, wherein the seller is unrelated by ownership to that specific retail outlet. Furthermore, independent claim 36 requires identifying, using a computer, the future time period during which the individual will visit the specific retail outlet. Finally claim 41 requires identifying, with the use of a computer, an individual known in advance by an administrator or supplier to be visiting within a future time period a specific retail outlet for pick up or return of a product. As a result, a retail outlet uses the shipping of one product to create the marketing opportunity for the sale of another product.

This permits target marketing to be very effective and direct. Therefore, at least independent claims 1, 36 and 41 are patentably distinct over the teaching of the Walker patent.

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Reconsideration and allowance of claims 1-41 are respectfully requested.

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